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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/351,102	07/08/1999	RICHARD L. BONKOWSKI	13676.142	9254

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 07/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/351,102

Applicant(s)

BONKOWSKI ET AL.

Examiner

Alicia Chevali r

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C.   133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7,9-28 and 42-57 is/are pending in the application.
- 4a) Of the above claim(s) 7,14,23-28 and 42-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-13, 18-22 and 53-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C.    119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C.   119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C.   119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C.    120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **RESPONSE TO AMENDMENT**

### ***WITHDRAWN REJECTIONS***

1. The 35 U.S.C. §103 rejection of claims 9-13, 18-22 and 53-57 Uyama et al. (5,700,550) in view of Coombs et al. (5,214,530) of record in paper #23, pages 4-5, paragraph #7 and repeated in paper #26, pages 2-4, paragraph #3 have been withdrawn due to Applicant's amendment in paper #28 and argument in paper #26, page 6, the last paragraph to page 7, the 4<sup>th</sup> paragraph.

### ***NEW REJECTIONS***

2. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 9 and 53-57 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 14, 66-68, 79 and 80 of copending Application No. 09/489,250 ('250). Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim similar security articles.

Application '250 claims an article comprising a carrier sheet, a release layer, a light transmissive substrate having a first surface and an opposing second surface, the first surface having an optical structure thereon; a color shifting optical coating on the on the second surface of the substrate, said optical coating including an absorber layer on the substrate, a dielectric layer on the absorber layer and a reflector layer on the dielectric layer, the optical coating providing an observable color shift as the angle of incident light or viewing angle changes; and an adhesive layer on the optical coating (claim 1 and 66). The optical structure is a diffraction grating pattern or holographic image pattern (claim 4). The substrate comprises a plastic material (claim 2).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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5. Claims 9-13, 18-22, and 53-57 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 14, 66-68, 79 and 80 of copending Application No. 09/489,250 ('250) in view of Coombs et al. (5,214,530).

Application '250 claims an article comprising a carrier sheet, a release layer, a light transmissive substrate having a first surface and an opposing second surface, the first surface having an optical structure thereon; a color shifting optical coating on the on the second surface

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of the substrate, said optical coating including an absorber layer on the substrate, a dielectric layer on the absorber layer and a reflector layer on the dielectric layer, the optical coating providing an observable color shift as the angle of incident light or viewing angle changes; and an adhesive layer on the optical coating (claim 1 and 66). The optical structure is a diffraction grating pattern or holographic image pattern (claim 4). The substrate comprises a plastic material (claim 2).

Application '250 claims all the instant claimed limitations except for the materials and/or thickness of the absorber, dielectric or reflector layers.

Coombs discloses an optical variable interference device, which has an observable color change at different viewing angles. The device can be utilized in optically variable interference devices or optical shifters for a thin film design. Coombs design has made it possible to achieve additional observable colors. See column 1, lines 10-24.

The device comprises an absorber layer, a dielectric layer, an absorber layer, a dielectric layer, a reflector, a dielectric layer, an absorber layer, a dielectric layer, and an absorber layer (figure 2). The reflector layer is made of material such as silver, aluminum, chromium, nickel, palladium, copper, or gold and have a thickness of approximately 400-1000 Angstroms (col. 2, line 59 through col. 3, line 9). The absorber layer maybe chromium with a thickness range of from 20 to 150 angstroms. The dielectric has a thickness of 400 to 1500 nanometers and made of materials such as magnesium fluoride or silicon oxide, where the index of refraction is less than or equal to 1.65. See column 3, lines 10-35.

It has been held that where claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical

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processes, a *prima facie* case of either anticipation or obviousness has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC 102 or on *prima facie* obviousness under 35 USC 103, jointly or alternatively. Therefore, the *prima facie* case can be rebutted by *evidence* showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). “When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

In the instant case, Coombs does not explicitly teach the limitations the dielectric layer has an optical thickness in the range from about 2 QWOT at a design wavelength of about 400 nm to about 9 QWOT at a design wavelength of about 700nm.

Therefore, in addition to the above disclosed limitations, the presently claimed property dielectric layer has an optical thickness in the range from about 2 QWOT at a design wavelength of about 400 nm to about 9 QWOT at a design wavelength of about 700nm would have (inherently/necessarily) been present because Coombs is using the same materials for the dielectric layer (i.e. magnesium fluoride or silicon oxide, where the index of refraction is less than or equal to 1.65), and there is no evidence currently of record showing that the disclosed prior art products do not necessarily possess the characteristics of the claimed product.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the optical variable interference device of Coombs as the transparent color shifting layers

of Application '250. One of ordinary skill would be motivated to do so because Coombs would provide Application '250 with additional observable colors making it hard to forge.

This is a provisional obviousness-type double patenting rejection.

***Allowable Subject Matter***

6. Claims 9-13, 18-22, and 53-57 will allowable upon timely filed terminal disclaimer in compliance with 37 CFR 1.321(c).

***REASONS FOR ALLOWANCE***

7. The following is an examiner's statement of reasons for allowance:

The prior art fails to teach or suggest the recited security article. The structural limitations that overcome the prior art of record include a security article comprising a light transmissive substrate having a first surface and an opposing second surface, the first surface having a diffraction grating pattern or a holographic image pattern and a color shifting multiplayer optical film on the second surface of the substrate, the optical film comprising an absorber layer on the second surface of the substrate, a dielectric layer on the absorber layer, and a reflector layer on the dielectric layer. The optical film provides an observable discrete color shift such that the article has a first background color at a first angle of incident light or viewing and a second background color different from the first background color at a second angle of incident light or viewing, the article exhibiting an optical diffraction grating pattern effect or a holographic image pattern in addition to the first and second background colors.

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The prior art of record specifically fails to teach a transparent substrate with a diffraction grating pattern or a holographic image pattern on one side and the claimed color shifting multiplayer optical film on the opposing surface.

8. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

9. Applicant's arguments regarding the 35 U.S.C. §103 rejection over Uyama et al. (5,700,550) in view of Coombs et al. (5,214,530) of record have been considered but are moot since the rejections have been withdrawn.

#### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

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7/22/03

